

REMARKS

I. Status of the Claims

In the Office Action dated October 27, 2008,¹ the Examiner took the following actions:

- (a) rejected claims 1-13 and 85 under 35 U.S.C. 101 as being directed to non-statutory subject matter; and
- (b) rejected claims 1-39 and 85 under 35 U.S.C. § 103(a) as being unpatentable over Dwyer, FR, "Customer Lifetime Valuation to Support Marketing Decision Making", 1997, Journal of Direct Marketing, Volume 11, Issue 4, John Wiley & Sons, pp. 6-13. ("Dwyer").

Applicants have amended claims 1, 14, 27-39, and 85. Claims 40-84 and 86-90 have been cancelled. Accordingly, claims 1-39 and 85 remain pending and under current examination. For at least the reasons stated below, Applicants traverse the rejections set forth in the Office Action.

II. Rejection under 35 U.S.C. § 101

The Examiner rejected claims 1-13 and 85 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Although Applicants traverse the rejection as being improper because claim 1 is tied to a particular machine or apparatus, in an effort to advance prosecution and without acquiescing to the propriety of the characterizations of the claims, Applicants have amended independent claim 1. As set forth in *In re Bilski*, "a claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or

¹ The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

(2) it transforms a particular article into a different state or thing." *In re Bilski*, 545 F.3d 943, at 954 (Fed. Cir. 2008) (en banc). At least because claim 1 recites "[a] method, implemented using a processor," "receiving, at a processor," "determining, using the processor," and "outputting, using the processor," claim 1 is tied to a particular machine and satisfies *In re Bilski*. Claim 1 is clearly within the reach of 35 U.S.C. § 101. As such, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of independent claim 1 and dependent claims 2-13 under 35 U.S.C. § 101.

Additionally, although Applicants traverse the rejection as being improper because claim 85 is not software per se, in an effort to advance prosecution and without acquiescing to the propriety of the characterizations of claim 85, Applicants have amended independent claim 85. Because claim 85 recites "an evaluation system," claim 85 is not composed of "components," and therefore cannot be considered software per se. Claim 85 is clearly within the reach of 35 U.S.C. § 101. As such, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of independent claim 85 under 35 U.S.C. § 101.

III. Rejection of Claims 1-39 and 85 under 35 U.S.C. § 103(a):

Applicants respectfully traverse the rejection of claims 1-39 and 85 under 35 U.S.C. § 103(a) as being unpatentable over Dwyer because a *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner

quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02 (I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

The Office Action incorrectly determines the scope and content of the prior art and fails to ascertain the sizable differences between the claimed invention and the prior art because *Dwyer* does not teach or suggest all the elements of the independent claims.

For example, amended independent claim 1 recites, among other things, "receiving . . . a production cost of the direct mail marketing campaign, wherein the production cost includes a fixed price component for the direct mail marketing campaign and an average price component per mailing unit for the direct mail marketing

campaign.” (Emphasis added). *Dwyer* does not teach or suggest these features, among others.

Instead, *Dwyer* discloses a system and method in which a “[c]ustomer lifetime value (LTV) is an important construct in designing and budgeting for customer acquisition programs and a number of other decision areas.” *Dwyer*, page 6, Abstract. *Dwyer* discloses “a simple element of account husbanding in the form of a holiday greeting card.” *Id.*, page 9, col. 2, lines 8-10. *Dwyer* further discloses “Renewal mailings @ \$275/M,” “Good will seasonal ‘Greeting’ to all subs at \$350/M,” and “direct costs @ \$28/1.2*.5 . . . [\$]25,560.” *Id.*, page 10, Exhibit 1. All the production costs in *Dwyer* are measured in price per units. *Id.*, page 10, Exhibit 1, page 12, Exhibit 2. That is, *Dwyer* teaches considering the average or per unit production costs, and not any of the fixed production costs. *Dwyer* does not disclose “wherein the production cost includes a fixed price component for the direct mail marketing campaign and an average price component per mailing unit for the direct mail marketing campaign,” as recited in claim 1 (emphasis added), because *Dwyer* does not disclose any fixed price production costs.

Because the systems and methods of *Dwyer* do not determine “receiving . . . a production cost of the direct mail marketing campaign, wherein the production cost includes a fixed price component for the direct mail marketing campaign and an average price component per mailing unit for the direct mail marketing campaign,” the Office Action fails to correctly determine the scope and content of the cited prior art and fails to ascertain the large differences between the invention of independent claim 1 and the cited prior art. For these reasons, amended independent claim 1 is not obvious in

view of *Dwyer*, whether taken alone or in combination, and the Examiner has failed to make a *prima facie* case of obviousness with respect to independent claim 1.

Consequently, claim 1 is allowable over the cited references.

Amended independent claims 14, 27, and 85, while of different scope, recite elements similar to those recited in claim 1, and are allowable for at least the reasons discussed above regarding claim 1. Claims 2-13, 15-26, and 28-39 depend from allowable independent base claims, and thus are allowable at least by virtue of their dependence, as well as by virtue of reciting additional features not taught nor suggested by the cited art. Accordingly, Applicants request the Examiner's reconsideration and withdrawal of the rejections of claims 1-39 and 85 under 35 U.S.C. § 103(a).

IV. Conclusion:

Applicants respectfully submit that the Office Action contains a number of incorrect assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicants respectfully decline to automatically subscribe to them.

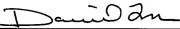
Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Daniel R. Lupo
Reg. No. 59,269